REMARKS

In the October 3, 2002 Office Action, the Examiner rejected the pending claims under 35 U.S.C. §§ 102, 103 and 112. Applicant wishes to thank the Examiner for bringing the typographical error in claim 54 to her attention. Correction has been made. With respect to the remaining rejections, Applicant firmly believes that her novel use of an aqueous based colorant composition for one-step coloring and highlighting of hair such that hair fibers may vary in tonality, hue, and/or shade is neither taught nor suggested by the prior art. Applicant firmly believes that the above amendments and the following comments will convince the Examiner that the rejection of claims 25 through 68 and 98 should be reconsidered and withdrawn.

I. THE INVENTION

The present invention discloses a composition and method for creating popular hair styles such as "streaking" or "chunking", where different segments of the colored hair show substantial shade variations.

Traditionally, streaked or chunked hair is created by first bleaching the hair and then coloring some portion of the hair with the desired hair color. This two step process is less than ideal. The bleach step often results in uneven removal of color from the hair. When this happens, the coloring step will not yield the desired shade. In addition, this process takes twice the time and may require heat, and since both bleach and colorant are usually highly alkaline, unnecessary hair damage frequently occurs. This current method

is particularly disadvantageous for African Americans who wish to chunk or highlight hair that has already been relaxed or straightened.

The present invention provides an improved composition for simultaneously coloring and highlighting hair. Compositions of the present invention comprise the following: inorganic persulfates, hydrogen peroxide, and cationic dyes. By mixing these components just prior to application to the hair, Applicant has avoided the stability problems associated with prior art compositions and has provided a one-step bleaching/coloring composition that represents a significant advance in the field.

The present invention also encompasses a method for simultaneously coloring and highlighting hair with the disclosed composition. The first step involves combining inorganic persulfates (in powder form) with an aqueous developer composition and an aqueous colorant composition. The aqueous developer composition and aqueous colorant composition comprise hydrogen peroxide and cationic dye, respectively. The next step is immediately applying the composition to a portion of the hair for a period of time sufficient for coloring and highlighting.

II. THE EXAMINER'S REJECTIONS

In the October 3, 2002 Office Action, the Examiner rejected claim 54 under 35 U.S.C. § 112. Applicant has amended the claim to overcome this rejection. The Examiner has also maintained the rejections of claims 25, 59 and 60 under 35 U.S.C. § 102(b) and claims 26-42 under 35 U.S.C. § 103(a) as unpatentable over Henkel for the reasons of record.

The Examiner's has similarly maintained his rejections of claims 25-47, 50-53 and 55-68 under 35 U.S.C. § 102(a) as being anticipated by Goldwell and claims 48 and 49 under 35 U.S.C. § 103(a) as being obvious over Goldwell in view of Yoshihara.

Finally, claim 98 was also rejected under 35 U.S.C. § 102(a) as being anticipated by Goldwell for the reasons of record found in the Office Action dated December 11, 2001.

In response to the Applicant's arguments filed June 11, 2002, the Examiner concludes that the "newly added limitation 'wherein said components are mixed together just prior to application to the hair' in instant claim 25 is a product by process limitation", and would be obvious to the skilled artisan. The Examiner further argued that "where the Examiner has found a similar product, the burden rests with the applicant to prove that the product is patentably distinct." (Citing In re Thorpe, 227 USPQ 964 (CAFC 1985); In re Marosi *et al.*, 218 USPQ 289; In re Pilkington, 162 USPQ 145). In the opinion of the Examiner, the "claimed composition [is] the same as those taught by Henkel when they are mixed together."

The Examiner argues that his combination of Goldwell and Yoshihara is appropriate since both references, being in the hair care field, are clearly analogous. Also, in the opinion of the Examiner, "the selection of silicone oils is an obvious variant of Goldwell's teachings since oils are conveniently used in hair care [sic] products, and have the added benefit of conditioning the hair, as taught by Yoshihara."

Applicant firmly believes that the amendment to claim 25 and the following remarks will convince the Examiner that the rejections of all pending claims should be reconsidered and withdrawn. In short, Applicant respectfully submits that the

Examiner's reliance on Henkel, Goldwell, and Yoshihara is misplaced. Applicant's invention is very different from the cited art.

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

The Examiner's rejection of claim 98 under 35 U.S.C. § 102(a) cannot stand. It is black letter law that to be anticipatory, a prior art reference must disclose each and every element of the claim or claims at issue. Applicant respectfully submits that Goldwell does not contain each and every element of claim 98. Specifically, Goldwell calls for a paraffin oil, i.e., a mixture of hydrocarbons having 11 or 12 carbons, while claim 98 requires C-12 isoparaffin, which is neither paraffin nor a paraffin oil.

Applicant respectfully submits that the Examiner's reliance on Henkel is misplaced, and all rejections based on Henkel are in error. Henkel is simply a bleaching agent, not a hair dye. It is true that Henkel does incorporate two very specific blue dyes – but he does so only to eliminate the red and yellow tints that can remain after darker hair is bleached. Henkel's blue dyes are not used to color the hair, they are used to remove or at least mask unattractive red and yellow tints. Henkel is quite clear that, regardless of initial hair color (i.e., from blonde to black), his "blonding powder" leaves the hair platinum blonde. This is a far cry from the present invention, which allows chunking and streaking of the hair, i.e., spot-to-spot variations that can range up to *ten shades and be any color*.

Moreover, Henkel does not teach either the component proportions or the immediate application required by amended claim 25. In fact, Henkel clearly teaches away from mixing ingredients at the time of use. The focus of Henkel's invention is the

discovery that two particular blue dyes – and only those two dyes -- can be premixed without instability. Henkel claims that other dyes, including presumably the dyes of Applicant's invention, are unstable in a persulphate/peroxide mix.

With respect to the Examiner's rejections based on Goldwell, the present amendment to claim 25 makes these rejections moot. Goldwell certainly does not teach or suggest a composition having the component percentages by weight of claim 25. Specifically, the present application discloses that in the preferred embodiment, one part persulfate is mixed with two parts peroxide and two parts dye. This is an important feature of the present invention. Chunking and streaking, particularly on sensitive or African-American hair, is accomplished by carefully limiting the amount of persulfate. If the persulfate level is not minimized, the resulting composition is too caustic for use with fragile hair types. Goldwell's persulfate levels are approximately *seven times higher* than the levels called for in Applicant's invention. In short, the composition of Goldwell is wholly unsuited for use in the present invention. Therefore, Goldwell neither anticipates nor renders obvious the invention as now claimed in amended claim 25. This argument applies with equal force to the rejection of claims 48 and 49. Since Goldwell can no longer be the basis of any rejection of the claims, the combination of Goldwell and Yoshihara is likewise no longer pertinent.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the present invention represents a patentable contribution to the art, and the application is in condition for allowance. Early and favorable action is accordingly solicited.

Respectfully submitted,

Date: April 3, 2003

John F. Ward
Reg. No. 33,811
WARD & OLIVO
708 Third Ave.
New York, NY 10017
(212) 697-6262

MARKED-UP VERSION OF AMENDED CLAIMS

--25. (AMENDED) A composition for simultaneously coloring and highlighting hair, said composition comprising:

approximately 1 part by weight of a powder bleach composition;

approximately 1.5 to about 5 parts by weight of an aqueous developer composition; and

approximately 1.5 to about 5 parts by weight of an aqueous based hair colorant comprised of one or more cationic dyes;

wherein said components are mixed together just prior to application to the hair.

--54. (AMENDED) A composition according to claim 53, wherein said alkoxylated [alkoxilated] alcohol is selected from the group consisting of:

products of a reaction of behenyl alcohol and ethylene oxide, wherein the number of repeated ethylene oxide units is 5 to 30;

products of a reaction of cetyl alcohol, stearyl alcohol and ethylene oxide, wherein the number of repeating ethylene oxide units is 2 to 100; or

products of a reaction of cetyl alcohol and ethylene oxide, wherein the number of repeating ethylene oxide units is 1 to 45.--